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09/136,483 08/19/98 KUMAR S N19.12-0016

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EXAMINER

MARCHESCHI, M

ART UNIT

PAPER NUMBER

1755

DATE MAILED:

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09/08/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/136,483

Applicant(s)

Kumar et al.

Examiner

Michael Marcheschi

Group Art Unit

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☒ Responsive to communication(s) filed on Jun 21, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3 and 5-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3 and 5-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Jun 21, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The disclosure is objected to because of the following informalities:

Throughout the specification applicants define application serial numbers and these should be updated to include the patent numbers, if appropriate.

Appropriate correction is required.

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite as to the phrase 'effectively no' since the examiner is unclear as to what this encompasses. This phrase does not define a clear limitation, thus rendering the scope of the claims unclear. This phrase should be canceled.

(I) Claims 1-3, 5-8 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Sugoh et al., (2) Ota et al., (3) Arai et al, (4) Moser or (5) Helble et al. (708) for the same reasons set forth in the previous office action which are incorporated herein by reference.

(II) Claims 1-3, 5-16 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Sakatani et al. alone or in view of Ueda et al. (2) Ueda et al.; (3) Atsugi et al. alone or in view of Ueda et al., (4) Rosenblum alone or in view of Ueda et al., (5) Zipperian alone or in

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view of Ueda et al., (6) Rostoker (130) alone or in view of Ueda et al., (7) Rostoker et al. (194) alone or in view of Ueda et al. or (8) Neville et al. alone or in view of Ueda et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 19-22 are added in these rejections because the prior art teaches size distributions which encompass the claimed size distributions.

(III) Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimo for the same reasons set forth in the previous office action which are incorporated herein by reference.

(IV) Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Sugoh et al., (2) Hardy et al., (3) Ota et al., (4) Arai et al., (5) Moser, (6) Helble et al. (708), (7) Sakatani et al., (8) Ueda et al., (9) Atsugi et al., (10) Rosenblum, (11) Zipperian, (12) Rostoker (130), (13) Rostoker et al. (194), (14) Wang or (15) Neville et al. as applied to claim 1 above, and further in view of Shimo for the same reasons set forth in the previous office action which are incorporated herein by reference.

(V) Claims 1-3, 5-16 and 19-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-9 and 11-16 of copending Application No. 08/961,735 for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claims 19-22 are added in these rejections because the prior art teaches size distributions which encompass the claimed size distributions.

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Applicant's arguments filed 6/21/99 have been fully considered but they are not persuasive.

Applicants argue that Sugoh et al. teach the production of silica particles and not alumina particles. The examiner fails to see this argument because it is specifically stated in column 2, line 51 of Sugoh et al. that alumina can be produced. Applicants also argue that Arai et al. and Moser do not teach the production of alumina particles. The examiner fails to see this argument because it is specifically implied in the abstract and column 2, line 51 of Arai et al. that alumina can be produced and Moser specifically states in column 5, lines 23-25, that alumina can be produced.

With respect to the particle size distribution, applicants argue that none of the references ((1) Sugoh et al., (2) Ota et al., (3) Arai et al, (4) Moser or (5) Helble et al. (708)) disclose the claimed size limitations. The examiner fails to see this argument because all the references disclose particles sizes which encompass the claimed range and it is well known that overlapping ranges are obvious **(the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549)**. In addition, applicants also argue that the references do not define the "tail" limitation. Again, the sizes overlap the claimed sizes and therefore a prima facie case of obviousness has been established. Applicants also apparently argue that the figures and/or the examples of some of the references do not disclose the claimed invention. Although this might be true, **"A reference is good not only**

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for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421. Finally, applicants appear to argue how the particles are produced, but this argument is irrelevant because the claims are only directed to the particles.

Applicants argue that Sakatani et al., Ueda et al., Atsugi et al., Rosenblum, Zipperian, Rostoker (130), Neville et al. and Rostoker et al. (194) fail to disclose the claimed size distribution. The examiner fails to see this argument because all the references disclose particles sizes which encompass the claimed range and it is well known that overlapping ranges are obvious (the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549). In addition, applicants also argue that the references do not define the "tail" limitation. Again, the sizes overlap the claimed sizes and therefore a prima facie case of obviousness has been established. Applicants also apparently argue that the figures and/or the examples of some of the references do not disclose the claimed invention. Although this might be true, "A reference is good not only for what it

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teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421. Finally, applicants appear to argue how the particles are produced, but this argument is irrelevant because the claims are only directed to the particles.

Applicants also argue that the particle size distribution of Rostoker et al. (194) is a gaussian distribution with a corresponding large tail. Applicants have not provided any evidence to support this. The conventional definition of a gaussian distribution is that the distribution curve has the shape of a normal probability curve (bell curve). This definition does not set forth that the distribution has a large tail. To support applicants contention, a reference directed to Siegel et al. is supplied. The examiner fails to see the relevance of this article and how it can be used to support applicants argument.

Since applicants have not provided any evidence (data) showing that the claimed size range is superior and provides unexpected results when compared to the size ranges disclosed by the prior art, no patentable distinction is seen to exist.

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Applicants apparently argue that Shimo does not teach the instantly claimed process because the reference uses a laser pulse. The examiner fails to see applicants argument because the reference process entails laser pyrolysis of a mixture of an organometallic precursor (aluminum) and an oxygen containing compound. Since the claimed process is directed to laser pyrolysis of a molecular stream (i.e. alumina precursor) and an oxygen containing compound (encompasses both an oxidizing agent and infrared absorber), it can be seen that the two processes are the same or reasonably similar. Since applicants have not provided any distinguishing factor between the two processes, no distinction is sere to exist. Applicants also argue that the reference does not teach the production of alumina particles. The examiner fails to see this argument because it is specifically stated in column 5, line 10-20 that an aluminum reactant can be used (i.e. thus inherently producing alumina). Although this is not exemplified, **"A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re LeGrice* 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)".** In addition, **"A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments"** See *In re Van Marter*, 144 USPQ 421.

With respect to the combination rejection of claims 17 and 18, applicants fail to argue the reasons for combining as set forth in the previous office action. The examiner acknowledges that

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all of the references (excluding Shimo) fail to teach laser pyrolysis, hence the reasons for the combination. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

In view of the teachings as set forth above, it is still the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

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Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548.

Evidence of unexpected results must be commensurate in scope with the subject matter claimed.

In re Linder 173 USPQ 356.

The drawing corrections filed 6/21/99 are approved by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi
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9/7/99



MICHAEL MARCHESCHI
PRIMARY EXAMINER